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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,645	09/25/2003	Ervin Goldfain	281-329.02 Con	7887
20874	7590	09/08/2004	EXAMINER	
WALL MARJAMA & BILINSKI 101 SOUTH SALINA STREET SUITE 400 SYRACUSE, NY 13202			SANDERS JR, JOHN R	
			ART UNIT	PAPER NUMBER
			3737	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/671,645

Applicant(s)

GOLDFAIN ET AL.

Examiner

John R. Sanders

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Inventorship

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Objections

2. Claims 4, 10, 12-15, 17, 19-21 and 27 are objected to because of the following informalities:

Claim 4 and 10 recite the limitation "said display". Claims 12-15 and 17 recite the limitation "said communication link". Claims 19-21 recite the limitation "said mating connectors". Claim 27 recites the limitation "said holder and said module" in line 1. There are insufficient antecedent bases for these limitations in the claims. Appropriate correction of the claims is required.

Double Patenting

3. Applicant is advised that should claims 5, 29 and 38 be found allowable, claims 7, 36 and 45 will be objected to under 37 CFR 1.75 as being a substantial duplicates thereof. When two

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claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-53 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-22 and 46-53 of copending Application No. 09/862,636. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one of ordinary skill in the art to move the module holder from the observer end to the patient end of the housing as a comparable apparatus design choice.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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6. Claims 54-87 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 and 46-53 of copending Application No. 09/862,636 in view of U.S. Patent No. 6,409,341 to Goldfain. It would have been obvious to one of ordinary skill in the art to combine the illumination and imaging systems of the '341 patent with the modular housing of 09/862,636 in order to reduce internal glare in the device.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 23, 24, 28, 32, 35, 88, 89 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,116,736 to *Stark et al.* *Stark et al.* discloses a hand-held housing (12) having an observer end (30) and a patient end (22); an off-axis illumination system disposed in the housing (24, 28); an imaging system disposed in the housing (16); an image sensor (14); and a processor system (34). *Stark et al.* also discloses an electronic display (36). Regarding claim 28, *Stark et al.* discloses a beamsplitter (18) that defines a pair of focal planes, one coinciding with the image sensor (14) and the other with the viewing port (22, 30). The absence of an eyepiece lens in *Stark et al.* does not render the reference irrelevant; it would have been obvious to one of ordinary skill in the art to include an eyepiece lens in the observer path in

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order to focus or magnify the image for the observer. Also, eyepiece lenses are common in ophthalmic instruments (e.g., see *Urban*, ref. 22).

9. Regarding claim 94, illumination systems containing condenser lens and mirrors are common in the art for focusing and directing the incident light toward the eye and would have been obvious to one of ordinary skill in the art to implement in the device of *Stark et al.*

10. Claims 25, 29 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Stark et al.* in view of U.S. Patent No. 6,152,565 to *Liu et al.*

Stark et al. discloses the above limitations but does not disclose expressly a communication link component. *Liu et al.* discloses a communication link component (FIG.1) between a hand-held corneal topography device and a computer.

Liu et al. and *Stark et al.* are analogous art because they are from class 351, eye examining and testing equipment.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a communication link with the apparatus of *Stark et al.* The suggestion/motivation for doing so would have been to communicate image data from the handheld device to an external unit. Therefore, it would have been obvious to combine *Liu et al.* with *Stark et al.* to obtain the invention as specified in claims 25, 29 and 36.

11. Claims 37, 41, 44, 90 and 91 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Stark et al.* in view of U.S. Patent No. 3,915,564 to *Urban*.

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Stark et al. discloses the above limitations but does not disclose expressly a moveable mirror. *Urban* discloses a moveable mirror (24, 24') that defines a focal plane at the camera (29) in the first position and at the eyepiece (22) in the second position.

Urban and *Stark et al.* are analogous art because they are from class 351, eye examining and testing equipment.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a moveable mirror in the apparatus of *Stark et al.* The suggestion/motivation for doing so would have been to operably switch between two optical paths. Therefore, it would have been obvious to combine *Urban* with *Stark et al.* to obtain the invention as specified in claims 37, 41 and 44.

12. Claims 38 and 45 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Stark et al.* in view of *Urban* and further in view of *Liu et al.*

Stark et al. and *Urban* disclose the above limitations but do not disclose expressly a communication link component. By the reasoning applied in paragraph 10 above, it would have been obvious to combine *Liu et al.* with *Stark et al.* and *Urban* to obtain the invention as specified in claims 38 and 45.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John R. Sanders whose telephone number is (703) 305-4974.

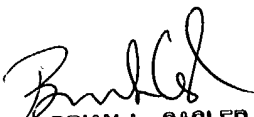
The examiner can normally be reached on M-F 8:30 am to 5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian L. Casler can be reached on (703) 308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GRK
Jrs


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700